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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,578	02/13/2002	Frank John Luciano III	CN920010005US1	1279
26502	7590	08/22/2006	EXAMINER	
IBM CORPORATION IPLAW IQ0A/40-3 1701 NORTH STREET ENDICOTT, NY 13760			PHUNKULH, BOB A	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,578

Applicant(s)

LUCIANO, FRANK JOHN

Examiner

Bob A. Phunkulh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to applicant's 06/05/2006 amendment(s)/response(s) in the application of **LUCIANO** for "**NET-AWARE TELEPHONE SWITCH**" filed 02/13/2002. The amendment/response to the claims have been entered. No claims have been canceled. No claims have been added. Claims 1-19 are now pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-11, 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by *Ménard* et al. (US 6,944,151), hereinafter *Ménard*.

Regarding claim 1, *Ménard* discloses a net-aware telephone switch (telephone to packet adaptor, see figure 1) providing IP phone service for a user of a communication terminal, the net-aware telephone switch comprising:

a two-line switch connecting with the communication terminal for switching outgoing calls between IP phone mode and PSTN phone mode (the controller 20

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switching between IP phone call from local area network 13 and PSTN phone from telephone set 12, see figure 1);

a CPU for sending and receiving IP phone mode calls to and from the net-aware telephone switch (the controller 20 is provided with CPU, see col. 3 lines 39-42);

storage for storing programs and data required for sending and receiving the IP phone mode calls (the controller 20 includes databases for storing program and other data, see col. 3 lines 39-42);

an Internet connector for connecting the net-aware telephone switch with the Internet (packet network interface 26, see figure 1); and

a bus for connecting together the two-line switch, the CPU, the storage, and the Internet connector (internal bus, see figure 1).

Regarding claim 2, *Ménard* discloses an A/D converter with an analog side connected with the two-line switch and a digital side connected with the bus, for converting telephone signals between analog form suited for the communication terminal and digital form suited for the net-aware telephone switch (d/a and a/d full duplex 18, see figure 1).

Regarding claim 3, *Ménard* discloses the Internet connector includes an Ethernet card (col. 7 lines 60-65).

Regarding claim 4, *Ménard* discloses the Internet connector includes a broadband modem (cable modem, see col. 3 lines 48-54).

Regarding claim 5, *Ménard* discloses the Internet connector includes a DSL modem (col. 7 lines 60-65).

Regarding claim 6, *Ménard* discloses the Internet connector includes a wireless modem (col. 7 lines 60-65).

Regarding claim 8, *Ménard* discloses a wireless port connected with the bus for receiving data input by the user through an input device (col. 7 lines 60-65).

Regarding claim 9, *Ménard* inherently discloses the wireless port includes an infrared transceiver (col. 7 lines 60-65).

Regarding claim 10, *Ménard* inherently discloses the wireless port includes a Bluetooth transceiver (col. 7 lines 60-65).

Regarding claim 11, *Ménard* discloses the storage further comprises: a parameters setting module, operated by the CPU to direct the user to set parameters for establishing a connection with an Internet service provider and a connection with an Internet telephone provider, and to direct the user to set an indicator indicating IP phone

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mode; an Internet connecting module, operated by the CPU to establish the connection with the Internet service provider; an IP phone initiating module, operated by the CPU to establish the connection with the Internet telephone provider; and an IP phone conversation module, operated by the CPU to enable the user to talk with a called end in IP phone mode (see col. 6 lines 31-49).

Regarding claim 13, *Ménard* discloses the parameters include an address of the Internet service provider and an address of the Internet telephone provider (see col. 7 lines 34-67).

Regarding claim 14, *Ménard* inherently disclose the parameters further include a first password associated with the Internet service provider and a second password associated with the Internet telephone provider (see col. 8 lines 25-50).

Regarding claim 15, *Ménard* discloses a smart card reader-writer for storing the parameters into a smart card inserted into the smart card reader-writer (the storage device 70 may be flash memory, see col. 6 lines 31-49).

Regarding claim 17, *Ménard* discloses a method for providing IP phone service for a user of a communication terminal, comprising the steps of:

establishing a connection with an Internet service provider and a connection with an Internet telephone provider (the telephone to packet adaptor is further connected to an server i.e. 38, 46, 52 via interface port 13, see figure 2);

receiving an outgoing call signal input by the user through the communication terminal (the telephone to packet adaptor receive incoming call from users connected to telephone set or from users connected to local area network 13, see figure 1 and figures 3-5);

determining whether the outgoing call signal includes information indicating that the outgoing call signal is an IP phone mode call (if the number in the database or if long distance number; see step 106 in figure 106; step 206 in figure 4; and step 306 in figure 306);

if the outgoing call signal includes information indicating that the outgoing call signal is an IP phone mode call, providing IP phone service for the user through the Internet telephone provider (see steps 110-116 in figure 3; steps 218-216 in figure 4; steps 320 –316 in figure 5); and

if the outgoing call signal does not include information indicating that the outgoing call signal is an IP phone mode call, routing the outgoing call signal to a public service telephone network (see steps 108-116 in figure 3; steps 208-216 in figure 4; steps 308 – 316 in figure 5).

Regarding claim 18, *Ménard* discloses converting an analog voice signal associated with the outgoing call signal to a digital voice signal; and converting the

digital voice signal into TCP/IP packets suitable for Internet transfer (see col. 5 lines 5-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ménard*.

Regarding claim 7, *Ménard* fails to disclose the telephone to packet adaptor includes a display for prompting the user for information.

However, it would have been obvious to one having ordinary skill in the art at the time of invention was made includes a monitor or screen or display in order to keep monitoring user's activities at the telephone to packet connector.

Regarding claims 12 and 19, *Ménard* fails to disclose that a digital certificate is stored in the storage and sent to the internet telephone provider for authentication.

It is well known in the art that digital certificate issued by a Certificate Authority is widely used for providing data or packet security in data communication.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to provides digital certificate in the system taught by *Ménard* for providing VOIP security.

Conclusion

Any response to this action should be mailed to:

The following address mail to be delivered by the United States Postal Service (USPS) only:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

The following address mail to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, Hand Delivery, etc.) as follow:

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220 20th Street South
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Arlington, VA 22202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bob A. Phunkulh** whose telephone number is **(571)**

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272-3083. The examiner can normally be reached on Monday-Tuesday from 8:00 A.M. to 5:00 P.M. (first week of the bi-week) and Monday-Friday (for second week of the bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor **Wellington Chin**, can be reach on **(571) 272-3134**. The fax phone number for this group is **(571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bob A. Phunkulh
Primary Examiner
TC 2600
Technology Division 2616
August 21, 2006

BOB PHUNKULH
PRIMARY EXAMINER